

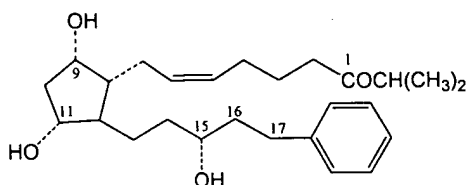
REMARKS

Claims 24 to 38 are pending in this application. Claims 25 to 28 and 30 to 38 have been withdrawn from further consideration by the examiner as being drawn to a non-elected invention. Elected claims 24 and 29 are under examination.

Claim Rejections - 35 U.S.C. §103

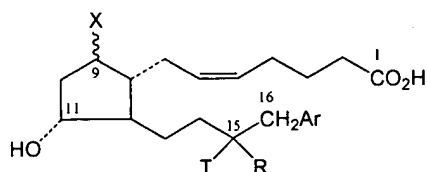
Claim 24 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hess et al. (U.S. Patent No. 4,011,262) in view of Boeckman et al. (Shioiri et al., J. Org. Chem 1986, 5489-5490). Claim 29 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hess in view of Boeckman (Shioiri) and further in view of Beitch et al. (Br. J. Pharmac, 1969, 158-167). Applicant respectfully disagrees with these rejections.

The invention, as defined by claims 24 and 29, distinguishes over Hess by claiming 13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester:



and compositions containing this compound for the treatment of ocular hypertension or glaucoma.

Hess does not teach or suggest any such compound or compositions. Instead, this reference teaches 13,14-dihydro-15-substituted- ω -pentanoprostaglandins of formula:



wherein Ar is phenyl or β -naphthyl; T is α -OH or β -OH; R is H; and X is α -OH or β -OH. Thus, this reference teaches compounds having different functional groups as well as having a different C-C backbone than the claimed invention.

Moreover, Hess teaches compounds which have different physiological activities (e.g., vasodilation to lower systemic arterial blood pressure; bronchodilation; control of the reproductive cycle; gastric acid secretion; and platelet aggregation), than the claimed invention (i.e., reduction of intraocular pressure). Indeed, this reference does not teach or suggest any 13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α} esters or compositions containing these compounds for the treatment of ocular hypertension or glaucoma as required by the claimed invention. Absent such a teaching or suggestion, one of ordinary skill in the art would not have been motivated to modify the teachings of Hess to arrive at the claimed invention. Nor would one of ordinary skill in the art,

based on their general knowledge of prostaglandins, have been motivated to modify the teachings of this reference to arrive at the claimed invention.

Boeckman (Shioiri) does not cure the defects of Hess because this reference does not teach or suggest esterification of 13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α} to provide the claimed invention. Instead, this reference teaches esterification of (S)-azetidine-2-carboxylic acid by refluxing azeotropically with benzyl alcohol and p-toluenesulfonic acid in benzene to provide the corresponding benzyl ester an intermediate in the synthesis of mugineic acid. Indeed, this reference does not teach or suggest esterification of any prostaglandin analogs. Absent such a teaching or suggestion, one of ordinary skill in the art would not have been motivated to modify or combine the teachings of these references to arrive at the claimed invention. Nor would one of ordinary skill in the art, based on their general knowledge of prostaglandins and organic chemistry, have been motivated to modify the teachings of these references to arrive at the claimed invention.

Beitch does not cure the defects of Hess and Boeckman (Shioiri) because this reference does not teach or suggest the use of 13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropyl ester for the treatment of ocular hypertension or glaucoma. Instead, this reference teaches that injection of prostaglandins into rabbit eyes produces a sustained rise in intraocular pressure. As such, one of ordinary skill in the art would not have been motivated to modify or combine the teachings of these references to arrive at the claimed invention. Nor would one of ordinary skill in the art, based on their general knowledge of prostaglandins and organic chemistry, have been motivated to modify or combine the teachings of these references to arrive at the claimed invention. Furthermore, because this reference teaches away from the claimed invention, Applicant submits that no reasonable expectation of success can be found for modifying or combining the teachings of these references to arrive at the claimed invention.

Applicant respectfully submits that a prima facie case of obviousness has not been established. The cited references do not teach, suggest or provide any motivation for one of ordinary skill in the art to modify or combine the teachings of these references to arrive at the claimed invention. Absent such a teaching or suggestion, a prima facie case of obviousness is not established. Applicant respectfully requests reconsideration and removal of these rejections.

Double Patenting

Claim 29 is rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 19 to 22 and 47 to 50 of U.S. Patent No. 5,422,368.

Applicant points out that the filing of a terminal disclaimer is not required in this case because no time-wise extension of the "right to exclude" over the '368 patent would result by the granting of a patent on the present application. As acknowledged in the Action, the present

application claims priority to, among others, the '368 patent, which claims priority to the parent Swedish applications. As such, any patent granted based on the present application would have the same expiry date as does the '368 patent. Applicant respectfully requests reconsideration and removal of this rejection.

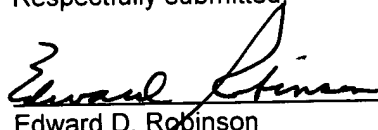
Conclusion

Applicants respectfully submit that the claims are in condition for allowance. Early Notice of Allowance is respectfully requested. Should there be any issues that have not been addressed to the Examiners satisfaction; Applicants invite the Examiner to contact the undersigned agent.

Applicant believes that no fees are due as this Amendment is timely filed. However, if any fees are due in connection with the filing of this response, please charge deposit account 500329.

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Respectfully submitted



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